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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,693	11/28/2000	Gyula Hadlaczky	24601-402G	7857

24961 7590 07/02/2002

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EXAMINER
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SHUKLA, RAM R

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 07/02/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/724,693	HADLACZKY ET AL.	
	Examiner	Art Unit	
	Ram Shukla	1632	

**-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 11-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 11-35 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <i>detailed action</i> .      |

**DETAILED ACTION**

1. Applicant's election without traverse of the invention of claims 1-6 and 11-35, directed to a method of amplifying a nucleic acid molecule in a cell by targeting it to an amplifiable region of a chromosome, and to nucleic acid molecules in Paper No. 16 is acknowledged.
2. Claims 7-10 have been cancelled.
3. It is noted that upon further examination it was determined that the invention of claims 1-6 and 11-35 required further restriction as discussed below.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 11-17, 30, 34, drawn to a method of amplifying a nucleic acid molecule in an animal cell by targeting it to an amplifiable region of a chromosome, and to nucleic acid molecules, classified in class 435, subclass 464.
  - II. Claims 1-4, 6, 11-15, 18-19, 30, 32, 33, and 35, drawn to amplifying a nucleic acid molecule in a plant cell by targeting it to an amplifiable region of a chromosome, and to nucleic acid molecules, classified in class 435, subclass 468.
  - III. Claims 20-29, drawn to a nucleic acid molecule comprising a nucleic acid encoding a gene product(s), a selectable marker, and targeting sequences, classified in class 536, subclass 23.1.
5. The inventions of Groups I and II encompass the limitations of the claims 1-4, 11-15, and 30. Should any of these groups be elected for prosecution, the invention of claims 1-4, 11-15, and 30 would be examined to the extent they encompasses the claimed invention.

6. Inventions III and I & II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case, nucleic acid of group III can be used for amplifying a nucleic acid in a plant cell (group II) or in an animal cell (group I). An animal cell and a plant cell are materially different products since they have different structure, different composition and different utilities. The nucleic acid of group III can also be used in in vivo or in vitro conditions, wherein the processes are materially different and used different steps.

Inventions of the group I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to processes that are carried out in animal or plant cells respectively. It is noted that while both the methods use the nucleic acid of group III, the steps and reactants for practicing the two methods are materially different. For example, animal and plant cells have different mode of operations and have different functions and utilities.

7. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if

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one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

When amending claims, applicants are advised to submit a clean version of each amended claim (without underlining and bracketing) according to § 1.121(c). For instructions, Applicants are referred to <http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>.

*Applicants are also requested to submit a copy of all the pending/under consideration claims.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the Dianiece Jacobs whose telephone number is (703) 305-3388.

Ram R. Shukla, Ph.D.



**RAM R. SHUKLA, PH.D**  
**PATENT EXAMINER**